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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,754	07/14/2003	Birgit Bossenmaier	39766-0114 A	3323

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EXAMINER
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HOLLERAN, ANNE L

ART UNIT	PAPER NUMBER
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1643

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/619,754

Applicant(s)

BOSSENMAIER ET AL.

Examiner

Anne L. Holleran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 29-39, 53-63 and 74-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28, 40-52 and 64-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/03, 1/05, 10/05, 1/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II (claims 26-28, 50-52 and 71-73, with linking claims 23-25, 40-49 and 64-70) in the reply filed on 6/19/2006 is acknowledged. The traversal is on the ground(s) that it would not place an undue burden on the examiner to search Group II along with Group VII. This is not found persuasive because the claims of Group II are drawn to methods of detection, whereas the inventions of Group VII are drawn to methods of treatment, and as explained in the Restriction requirement the search and examination for inventions of Group II is not coextensive with the search and examination of the inventions of Group VII.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-88 are pending. Claims 1-22, 29-39, 53-63 and 74-88, drawn to non-elected inventions, are withdrawn from consideration.

Claims 23-28, 40-52 and 64-73 are examined on the merits.

### ***Claim Rejections - 35 USC § 112***

3. Claims 23-28, 40-52, and 64-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23, 47 and 71 are indefinite because it is not clear what the scope of "detecting phosphorylation" is. Is it a detection of a degree of phosphorylation? This is unclear in the

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specification because in the working examples that relate to Figure 4, it appears that detection of phosphorylation may be related to detection of a certain level of phosphorylation, because it appears that cells with low levels of phosphorylation are not responsive to antibody 2C4, whereas cell with high levels of phosphorylation are responsive to antibody 2C4. Further, there is heterogeneity, because one of the three responsive cells has much lower levels of Her2 phosphorylation than the other two responsive cells.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-28, 40, 42, 46-52, 64, 66, and 70 are rejected under 35 U.S.C. 102(b) as being anticipated by Thor (Thor, A.D. et al., Journal of Clinical Oncology, 18(18): 2000, 3230-3239, 2000).

The claimed methods comprise the active steps of providing a biological sample comprising HER2-positive tumor cells and detecting the phosphorylation of an ErbB receptor in said biological sample. The phosphorylation of an ErbB2(HER2) receptor is detected. The sample may be tissue sample obtained from a tumor biopsy, and the tumor may be a breast

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tumor, and the ErbB receptor phosphorylation may be determined by immunohistochemistry.

The intended use of the claimed methods is for identifying tumor cells as responsive to treatment with an antibody inhibiting the association of HER2 with another member of the ErbB receptor family, wherein the antibody binds HER2, or the anti-Her2 antibody blocks ligand activation of an ErbB heterodimer comprising HER2 or wherein the antibody is rhuMAb 2C4. The intended use may also be for predicting the response of a subject diagnosed with a HER2-positive tumor to treatment with an antibody inhibiting the association of HER2 with another member of the ErbB receptor family.

Thor teaches the use of immunohistochemistry to detect phosphorylation of ErbB2 in breast cancer tissue samples (see page 3232, 1<sup>st</sup> column and page 3233, 2<sup>nd</sup> column, description of Groups A, B and C, where groups B and C are patient groups that are ErbB2 positive and the phosphorylation of ErbB2 is detected). Thus, Thor teaches the claimed methods because Thor's methods comprise the same active steps as recited in the claims.

Thor's method does not appear to have the same intended use as the intended use set forth in the claims. However, the active steps in Thor are the same as in the claims and the intended use recited in the claims does not appear to materially affect the active steps of the claimed methods.

5. Claims 23-28, 40, 42-44, 47-52, 64, and 66-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Wildenhain (Wildenhain, Y. et al., *Oncogene*, 5(6): 879-883, 1990; abstract only).

The claimed methods comprise the active steps of providing a biological sample comprising HER2-positive tumor cells and detecting the phosphorylation of an ErbB receptor in said biological sample. The phosphorylation of an ErbB2(HER2) receptor is detected. The sample may be tissue sample obtained from a tumor biopsy, and the tumor may be a breast tumor, and the ErbB receptor phosphorylation may be determined by immunoprecipitation of the ErbB receptor and Western blot analysis, where the ErbB receptor is indicated by the presence of a phosphor-ErbB receptor band on the gel. The intended use of the claimed methods is for identifying tumor cells as responsive to treatment with an antibody inhibiting the association of HER2 with another member of the ErbB receptor family, wherein the antibody binds HER2, or the anti-Her2 antibody blocks ligand activation of an ErbB heterodimer comprising HER2 or wherein the antibody is rhuMAb 2C4. The intended use may also be for predicting the response of a subject diagnosed with a HER2-positive tumor to treatment with an antibody inhibiting the association of HER2 with another member of the ErbB receptor family.

Wildenhain teaches the use of immunoblotting with anti-neu (anti-Her2 or anti-ErbB2) antibodies and antiphosphotyrosine antibodies to detect phosphorylation of ErbB2 in breast cancer tissue samples (see abstract). Thus, Wildenhain teaches the claimed methods because Wildenhain's methods comprise the same active steps as recited in the claims.

Wildenhain's method does not appear to have the same intended use as the intended use set forth in the claims. However, the active steps in Wildenhain are the same as in the claims and the intended use recited in the claims does not appear to materially affect the active steps of the claimed methods.

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6. Claims 23-28, and 42-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Xu (Xu, F.J. et al. *Int. J. Cancer*, 59: 242-247, 1994).

Xu teaches Western transfer to detect p185 (Her2) phosphorylation in SKBr3 breast cancer cells (see page 244: Figure 2, 1<sup>st</sup> column, first full paragraph, also Table I, and also page 244, 2<sup>nd</sup> column, 2<sup>nd</sup> paragraph). Therefore, Xu teaches the claimed methods because Xu's method comprises the same active steps as recited in the claims.

Xu's method does not appear to have the same intended use as the intended use set forth in the claims. However, the active steps in Xu are the same as in the claims and the intended use recited in the claims does not appear to materially affect the active steps of the claimed methods.

7. Claims 23-28, and 42-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Ignatoski (Ignatoski, K.M.W., et al., *Endocrinology*, 140: 3615-3622, 1999).

Ignatoski teaches phosphotyrosine Western blot analysis of protein obtained from MCF-10erbB02 and H16N2erbB02 cells to detect p185<sup>erbB2</sup> phosphorylation (see page 3619: Figure 3, 1<sup>st</sup> column) and also to detect erbB-3 phosphorylation (page 3619, 2<sup>nd</sup> column) in MCF-10A and H16N2 breast cancer cells. Therefore, Ignatoski teaches the claimed methods because Ignatoski's method comprises the same active steps as recited in the claims.

Ignatoski's method does not appear to have the same intended use as the intended use set forth in the claims. However, the active steps in Ignatoski are the same as in the claims and the intended use recited in the claims does not appear to materially affect the active steps of the claimed methods.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 23, 41, 47, 65 and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiGiovanna (DiGiovanna, M.P. et al. Cancer Research 55: 1946-1955, 1995) in view of Terstappen (US 6,365,362; issued Apr. 2, 2002; effective filing date Nov. 30, 1998).



Claims 71-73 are drawn to methods for identify a subject responsive to treatment with an anti-Her2 antibody, comprising detecting phosphorylation of an ErbB receptor in circulating tumor cells and determining that the subject is likely to respond to treatment with an anti-Her2 antibody if phosphorylation is detected.

Claims 23, 41, 47 and 65 comprise methods where phosphorylation of an ErbB receptor in circulating tumor cells is detected.

DiGiovanna teaches use of immunohistochemistry on formalin-fixed and paraffin-embedded surgical specimens from human breast tumors (see page 1948, 1<sup>st</sup> column, and 1950, 1<sup>st</sup> and 2<sup>nd</sup> column, bridging paragraph) using the PN2A antibody, which is specific for phosphorylated Her2. DiGiovanna also teaches that the extent of p185 (Her2) tyrosine phosphorylation varies considerably, and that it is highly likely that measurement of p185 signaling activity as opposed to p185 abundance will greatly enhance methods that use detection of p185 for prognosis and treatment decisions, and that tumors most vulnerable to anti-p185 antibodies will be those that are dependent upon p185 signaling for growth (see page 1954, 1<sup>st</sup> column). DiGiovanna fails to teach the method using samples of circulating tumor cells.

However, Terstappen teaches that carcinoma cells in the blood may be assay immunocytochemically to characterize the circulating tumor cells. Terstappen teaches that the methods may be used to monitor patients for recurrence of cancer or for response to therapy, and teaches that levels of tumor markers such as Her2 may be assessed (see abstract; and column 8, lines 29-57 and column 9, line 54 – column 10, line 51).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified DiGiovanna's method so that it could be used in

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the measurement of Her2 phosphorylation status of circulating tumor cells. One would have been motivated to have combined the teachings of DiGiovanna and Terstappen because collecting a blood sample to analyze the Her-2 status of circulating cancer cells is less invasive than collecting a tissue sample from the cancer.

9. Claims 23, 43, 45, 47, 67 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiGiovanna (DiGiovanna, M.P. et al. Cancer Research 55: 1946-1955, 1995).

The claimed methods encompass methods of detection of Her2 phosphorylation comprising first using immunoblot techniques to detect phosphorylated Her2 and then confirming the result with immunohistochemistry using a phospho-specific anti-ErbB2 receptor antibody.

DiGiovanna demonstrates an immunoblot technique, where a phosphor-ErbB receptor band on a gel is detected and separately an immunohistochemistry technique using a phospho-specific anti-ErbB2 receptor antibody (see Figure 1 and see Figure 6). DiGiovanna fails to teach a method where first the immunoblot technique is used and then the immunohistochemical technique is used for confirmation of the first technique.

However, DiGiovanna teaches that the prior art teaches methods of quantification of tyrosine receptor phosphorylation in tumor samples by immunoprecipitation of receptors and then immunoblotting with an anti-phosphotyrosine antibody, and that such experiments are subject to inaccurate interpretations because of variability in tissue content of stroma/normal cells versus tumor cells and because of tumor cell heterogeneity. DiGiovanna further teaches that use of specific antibody against phospho-Her2 allows direct staining of intact tissue for

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specific activated receptors (see page 1950, 2<sup>nd</sup> column). Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have used DiGiovanna's immunohistochemical method to confirm earlier results obtained by immunoprecipitation followed by immunoblotting. One would have been motivated to have done so because of DiGiovanna's teachings that immunoblotting techniques may result in inaccurate interpretations.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Holleran, whose telephone number is (571) 272-0833. The examiner can normally be reached on Monday through Friday from 9:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached on (571) 272-0832. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Official Fax number for Group 1600 is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Anne L. Holleran  
Patent Examiner  
September 15, 2006



**LARRY R. HELMS, PH.D.**  
**SUPERVISORY PATENT EXAMINER**